

## REMARKS

Five Appeal Briefs have been previously filed. Each one somehow caused the Examiner to reopen prosecution. Nevertheless, reconsideration is again respectfully requested.

### APPLICATION STATUS

Claims 1-30 are pending.

### Rejections

#### 35 U.S.C. § 112, first paragraph, rejections

Claim 12 was rejected pursuant to 35 U.S.C. § 112, first paragraph.

#### 35 U.S.C. § 103(a) rejections

Claim 12 was rejected under 35 U.S.C. § 103(a) as obvious over Morioka (US 5,650,605) in view of Wagner (US 5,742,845).

#### Nonstatutory obviousness-type double patenting rejections

1. Claims 1-2, 8-9, 12-17, and 22-23 were rejected over certain claims in US 6,965,879.

Specifically:

Claims 1-2 and 8 were rejected over claim 3;

Claim 9 was rejected over claim 4;

Claim 12 was rejected over claims 1, 3, or 4;

Claims 13 and 16 were rejected over claims 1 and 3; and

Claims 14-15, 17, and 22-23 were rejected over claim 3.

2. Claim 12 was rejected over claim 2 in US 6,539,361.
3. Claim 12 was rejected over claim 9 in US 7,062,464.

4. Claims 1, 7, and 12 were rejected over certain claims in US 6,289,320. Specifically:

Claims 1 and 7 were rejected over claim 8; and

Claim 12 was rejected over claims 1-14.

Provisional nonstatutory obviousness-type double patenting rejections

1. Claims 8 and 12 were rejected over certain claims in 09/077,337. Specifically:

Claim 8 was rejected over claim 31.

Claim 12 was rejected over claims 31, 38, 48, and 50-54.

2. Claim 12 was rejected over claim 55 in 09/233,249.

3. Claim 12 was rejected over claim 14 in 10/980,209.

4. Claim 12 was rejected over claims 21-22 and 25-26 in 09/578,291.

5. Claim 12 was rejected over claims 26-28 in 09/639,310.

6. Claim 12 was rejected over claims 5-7 in 10/357,145.

7. Claim 12 was rejected over claim 1 in 10/430,123.

8. Claim 12 was rejected over claims 21 and 23 in 10/957,287.

9. Claim 12 was rejected over claim 34 in 11/226,104.

10. Claim 12 was rejected over claims 31-38 in 11/226,540.

Allowance

Independent claim 11 is regarded by Applicants to be allowed by the Office. Claims 3-6, 10, 18-21, and 24-30 are regarded by Applicants to be objected to by the Office but would be allowed if rewritten in independent form. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). If Applicants view of the status of these claims (which is consistent with the record) somehow disagrees with the Examiner's view, then the Action is defective.

## **RESPONSE TO THE REJECTIONS**

Applicants respectfully traverse the rejections. The Appeal Brief dated December 28, 2007 is herein incorporated by reference.

### **The 35 U.S.C. § 112, first paragraph, rejection**

For reasons already set forth in the Appeal Brief, Applicants' application meets the requirements of 35 U.S.C. § 112, first paragraph, with regard to claim 12.

### **The 35 U.S.C. § 103(a) rejection**

For reasons already set forth in the Appeal Brief, Morioka in view of Wagner does not render claim 12 obvious.

The rejection of claim 12 is also faulty because it does not correctly apply the level of ordinary skill in the art at the time of the present invention. Rather, the Examiner improperly applied a "2008" level of ordinary skill in the art. The rejection is further faulty because, in contrast to an understanding of Wagner by a person having ordinary skill in the art at the time of the present invention, it is based on (the Examiner) improperly attributing both enablement to Wagner and features to Wagner which are not taught or suggested by Wagner.

### **The applicable legal standard for "obviousness" has not been met by the Office**

In order to present a valid rejection based on obviousness, it is first necessary for the Office to make a *prima facie* showing of obviousness. *Prima facie* obviousness requires a showing that each of the recited features and relationships in the claims was known in the prior art. If the Office fails to establish a *prima facie* case of obviousness, then an Applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Even in cases where the Office has established a *prima facie* showing of obviousness, a rejection cannot be properly made unless there is a requisite showing that it would have been obvious to one having ordinary skill in the art at the time the invention was made, to have combined features and relationships to have produced (at that time) the invention as claimed. In accordance with the dictates of the United States Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007), the determination as to whether there is a reason to combine prior art features must be evaluated through an analysis of the factors recited in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The factual inquiries that must be made under *Graham* include:

- (a) determining the scope and content of the prior art,
- (b) ascertaining the differences between the prior art and the claims in issue,
- (c) resolving the level of ordinary skill in the pertinent art, and
- (d) evaluating evidence of secondary consideration.

The Action fails to present a proper *Graham* analysis

In accordance with the requirements of *Graham*, it is mandatory that before a claim can be rejected on the basis of obviousness, the Office is required to make a factual determination and resolve the level of ordinary skill in the pertinent art at the *time* the invention was made. MPEP § 2141(2)(C). It is respectfully submitted that the Action does not include such a full determination. That is, there is no evidence of record that the level of one of ordinary skill in the art at the time of Applicants' invention has been resolved by the Office. Nor has the record established the Examiner to be a person of ordinary skill in the art at the time of Applicants' invention.

The rejection is not based on one of ordinary skill in the art at the time of the present invention

The record shows that the reasons for combining features of the references in the rejection is based on the opinion of the Examiner. Thus, it must be concluded that the basis for combining features of the cited references in the rejection is *not* based on the opinion of a person of ordinary skill in the art at the time of the present invention. That is, the alleged reasons for combining features of the cited references is at best based on the mere opinion of the Examiner, which opinion is entitled no evidentiary weight because the Examiner is *not* a person of ordinary skill in the art at the time of the present invention. For this additional reason, Applicants respectfully submit that the rejection is legally improper and should be withdrawn.

The declarations pursuant to 37 C.F.R. § 1.132

A declaration under 37 C.F.R. § 1.132 is submitted herewith. The declaration is from a person with actual knowledge of the relevant art and the level of ordinary skill in the art at the time of the present invention. The declaration further establishes that the relied upon combination of references does not provide any teaching, suggestion, motivation, or valid reason to a person of ordinary skill in the art at the time of the present invention to have produced the recited invention. That is, the declaration provides further evidence that even with full view of the applied prior art, the recited subject matter (especially that of claim 12) would *not* have been obvious to a person of ordinary skill in the art at the time of the invention. It is well settled that “weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him.” *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967).

Also submitted herewith is a copy of a 37 C.F.R. § 1.132 declaration previously filed in application 09/639,310 (which application is applied by the Examiner in the Action). This declaration further supports Applicants' contention that the claim 12 subject matter would *not* have been obvious to a person of ordinary skill in the art at the time of the present invention. This declaration also attests to Wagner's disclosure being non-enabling, which precludes Wagner from being a legally viable reference.

**The nonstatutory obviousness-type double patenting rejections**

Applicants respectfully traverse the obviousness-type double patenting rejections. The Office can only rely on *claimed* subject matter when presenting an obviousness-type double patenting rejection. However, the record indicates that the Office relied on the entire disclosure of the applied patents. Nor does the record properly provide a side-by-side comparison of the involved recited subject matter. Nevertheless, in order to advance prosecution, a terminal disclaimer is filed herewith with regard to U.S. Patents 6,965,879; 6,539,361; 7,062,464; and 6,289,320. Acceptance thereof is respectfully requested.

**The provisional nonstatutory obviousness-type double patenting rejections**

Applicants respectfully traverse the *provisional* obviousness-type double patenting rejections. The record does not support the rejections. For example, the record lacks a side-by-side comparison of the involved recited subject matter. Furthermore, the rejections can only rely on *claimed* subject matter. However, the record indicates that the rejections improperly rely on the entire *disclosures* of the applied applications.

Terminal disclaimers were previously filed with regard to applied applications 09/578,291; 10/357,145; and 10/430,123. Thus, the rejections based thereon are moot.

As a result of the terminal disclaimers, the only remaining nonstatutory obviousness-type double patenting rejections will involve applications 09/077,337; 09/233,249; 10/980,209; 09/639,310; 10/957,287; 11/226,104; and 11/226,540. However, these nonstatutory obviousness-type double patenting rejections are merely *provisional*. They are "provisional" because none of the allegedly conflicting claims has yet been patented to justify a *legal* double patenting rejection. As a result, on appeal the Board will not need to decide the provisional rejections, but only whether claim 12 is unpatentable with regard to the 35 U.S.C. § 112 issue and the 35 U.S.C. § 103(a) issue.

USPTO examining procedures dictate that if provisional nonstatutory obviousness-type double patenting rejections are the only rejections remaining, then the Office must withdraw the rejections and permit that application to issue as a patent without need of a terminal disclaimer. MPEP § 804(II).

Furthermore, it is well known that in comparison to fixed claims in a patent, claims in pending applications are relatively fluid as they are subject to change. This is why the examining procedures (MPEP) require one of the applications involved in a provisional rejection to be freed as a patent without need of a terminal disclaimer. Otherwise, without one of the applications becoming a patent, an Examiner (as in the current situation) would play a game of trying to keep apprised of ever changing claims. At best, such a game can only result in a stalemate of provisional nonstatutory obviousness-type double patenting rejections, with no application maturing to a patent to enable a *legal* (not provisional) double patenting rejection.

## **AMENDMENTS PROPOSED BY APPLICANTS**

After acceptance of the terminal disclaimers, the only issues remaining are:

- 1). A 35 U.S.C. § 112, first paragraph, rejection of claim 12.
- 2). A 35 U.S.C. § 103(a) rejection of claim 12.
- 3). Provisional nonstatutory obviousness-type double patenting rejections of claim 12.
- 4). A provisional nonstatutory obviousness-type double patenting rejection of claim 8.

Therefore, Applicants (below) propose amendments with respect to claims 8 and 12.

Applicants respectfully submit that these amendments will resolve all issues.

### **Claim 12**

Applicants currently agree to cancellation of claim 12 by Examiner's amendment in allowing this application. Applicants reserve all rights to refile claim 12 in another application (e.g., continuation or divisional application).

### **Claim 8**

Applicants are willing to compromise on pending claim 8. Applicants currently agree that they will cancel claim 31 (and claim 48/31) in application 09/077,337, *subject to* the Examiner first agreeing to amend pending claim 8 by Examiner's amendment to recite "An automated banking machine" instead of "An Automated Teller Machine (ATM)". Applicants await a phone call (or e-mail, etc.) from the Examiner accepting the agreement.

### **Result of the amendments proposed by Applicants**

As a result of Applicants' above agreements, there will be no other outstanding issues in this application. Thus, Applicants' agreements will place this application in condition for allowance.



Applicants' agreements resolve all issues and bring an end to the extraordinary lengthy prosecution. Applicants see no reason for the Examiner not to accept Applicants' agreements, except to unnecessarily prolong prosecution. Should the Examiner not accept Applicants' agreements, then Applicants have no other choice but to let the claim 12 rejection proceed to decision by the Board (which already found pending claim 12 acceptable in their prior decision).

#### **Additional Comments**

As this application was filed in 1998, it is subject to former 35 U.S.C. § 154(b) and 37 CFR 1.701. This application claims benefit to earlier priority and is also subject to terminal disclaimer. Thus, prosecution delay time caused by the Office is patent term time that Applicants cannot recoup (without lawsuit). As a result, even if a patent were instantly granted on this application, its term of effectiveness would already be less than half of that allocated to a normal patent. The prosecution record (nine non-final rejections, etc.) gives the impression that the Office purposely continues to unnecessarily prolong prosecution so there eventually will not be any viable effective patent term remaining for Applicants. Thus, refusal by the Examiner to accept Applicants' above agreements (or suggest some other amicable agreement) will be viewed as part of a predetermined plan by the Office to wilfully shorten granted patent effectiveness.

#### **CLARIFICATION IS REQUESTED**

The Action refers to three (3) different art units. For example, note the cover sheet (art unit 3685); Summary sheet and form PTO-892 (art unit 3621); and pages 2-31 (art unit 4137). Clarification regarding the correct art unit is respectfully requested.

**CONCLUSION**

Applicants respectfully submit that this application is in condition for allowance. The undersigned is willing to discuss any aspect of the Application at the Office's convenience.

Respectfully submitted,



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